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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,884	11/13/2001	Hiroyuki Onishi	U 013711-6	5111
140	7590	04/03/2006	EXAMINER	
LADAS & PARRY 26 WEST 61ST STREET NEW YORK, NY 10023			FLETCHER III, WILLIAM P	
			ART UNIT	PAPER NUMBER

1762

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/009,884

Applicant(s)

ONISHI ET AL.

Examiner

William P. Fletcher III

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-71 is/are pending in the application.  
4a) Of the above claim(s) 4-7 and 11-66 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,8-10 and 67-71 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment and response filed 3/13/2006 are noted. Claims 1 and 4-71 are pending. Claims 4-7 and 11-66 remain withdrawn from consideration.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 8-10, and 67-71 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 8-10, and 67-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al. (US 5,480,768 A) in view of Idota et al. (US 4,301,236 A).

6. Ishida is applied again here as detailed in the prior Office action.

Applicant has amended the independent claims to recite that the recorded matter (i) has at least a cyan image recorded therein and (ii) that the treatment agent forms a protective layer on the recorded matter, neither of which are taught by Ishida.

With respect to (i), Ishida teaches that the photographic element that is treated may be a silver halide color photographic element and that the treatment may take place after the color image is developed (as in the case of the bleach or bleach-fixing thiocyanate treatment) [1:1-2:40 and 38:6-18]. Idota teaches a silver halide photographic element that contains a cyan image forming layer that may be treated by bleaching after developing [14:26-49]. Consequently, it would have been obvious to one of ordinary skill in the art to modify the process of Ishida so as to utilize, as the developed silver halide color photographic element, an element that contains a cyan image. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of successfully providing a color image that may be treated by bleaching.

With respect (ii), it is the examiner's position that any coating of a treatment fluid necessarily forms at least a physical barrier over the cyan image and thus reads on

applicant's claimed "protective layer" (claim 1) and "a protective layer...to protect at least the cyan image" (claim 69).

7. With respect to newly added claims 70 and 71, neither Ishida nor Idota teach that the treatment agent is applied in the amount claimed.

It is the examiner's position that the amount of treatment agent, in particular the thiocyanate bleaching or bleach-fixing agent, is a result-effective variable. The amount applied must be enough to achieve the desired effect, without being so great as to damage the image or be wasteful of material.

Consequently, absent a showing of unexpected results demonstrating the criticality of the claimed amounts of treatment agent, it would have been obvious to one of ordinary skill in the art to optimize the amount of treatment agent applied by routine experimentation.<sup>1</sup>

With specific respect to claim 71, as noted above, it is the examiner's position that any coating of a treatment fluid necessarily forms at least a physical barrier over the cyan image and thus reads on applicant's claimed "overcoat layer."

### *Conclusion*

8. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing

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<sup>1</sup> MPEP 2144.05(II)

an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore include an explicit citation (i.e., page number and line number) of that/those portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/20/2006



William Phillip Fletcher III  
Patent Examiner, USPTO  
Art Unit 1762



TIMOTHY MEEKS  
SUPERVISORY PATENT EXAMINER